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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,435	10/01/2003	Maria Hanna Joseph	18973-00001	7020

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EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,435

Applicant(s)

JOSEPH, MARIA HANNA

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 12 recites the limitation "the surface" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rollman (5,011,032).

Rollman discloses a method of providing permanent or removable indicia comprising information (4, 10, 11) on at least one of the top, bottom and side surfaces of a lid (1) for cups or containers that have a lip (as seen in figure 3, the lip being located near arrow) and hold pills, capsules or tablets intended for consumer consumption, the lid having a top with top and bottom surfaces and an integral side circumference area which fits over the lip of the container and is virtually perpendicular to the top of the lid (as seen in figures 1-3), the method comprising providing a lid (1) for

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a container (8) that holds pills, capsules or tablets, the lid defining an integral top, side and bottom surfaces (see column 3, lines 46-56 and figures 1-3); and placing indicia (4, 10, 11) on at least one of the top, bottom and side surfaces of the lid (see column 3, lines 46-56, 59-68 through column 4, lines 1-4 and figure 1).

Regarding claim 2, the lid is made of thermosetting plastic (see column 4, lines 4-8).

Regarding claim 3, the process of placing the indicia on the lid does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claim 4, Rollman inherently discloses the indicia being of any size or dimension necessary to fit or accommodate any and all sizes and styles of lids since the indicia is molded with the lid during manufacture and would be sized accordingly (see column 3, lines 59-64).

Regarding claims 5 and 7, Rollman discloses the indicia (4 and 10) being permanently displayed directly on the lid (molded with the lid).

Regarding claims 6, 8 and 9, Rollman discloses the indicia (11- break-off tabs) being temporarily and indirectly displayed on the lid (see column 4, lines 38-42).

Regarding claim 12, Rollman discloses a method of providing advertisement indicia (4, 10, 11) on the surface of a lid (1) for containers that have a lip (as seen in figure 3, the lip being located near arrow) and hold pills, capsules or tablets intended for consumer consumption, the lid having a top with top and bottom surfaces and an

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integral side circumference area which fits over the lip of the container and is virtually perpendicular to the top of the lid (as seen in figures 1-3), the method comprising providing a thermosetting plastic lid (1) for a container (8); and placing advertising indicia (10, 11 – advertising to the patient the number of dosage units to take) on at least the side of the lid (see column 3, lines 46-56, 59-68 through column 4, lines 1-4 and figure 1).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rollman in view of Rollman.

Rollman discloses the claimed invention except for the specific arrangement and/or content of indicia (advertising indicia) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the lid, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the

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substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rollman in view of Comann ('045).

Rollman discloses the claimed invention except for the removable coupling being accomplished with a peel-off sticker.

Comann discloses a beverage container for providing identification information comprising a regular label (11) containing a removable label (14) (see figures 3 and 4). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Rollman's invention to include a removable label, as taught by Comann, to enable the removable label to be subsequently placed on other surfaces.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rollman in view of Lundell ('713).

Rollman discloses the claimed invention except for the removable coupling being accomplished with a perforated, tear-off member.

Lundell discloses a container for providing information having a label (11) with a main portion (12) and a secondary portion (15); wherein the secondary portion can be

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easily lifted up and stripped off of the main portion along the perforation (16) (see figure 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Rollman's invention to include a perforated, tear-off member, as taught by Lundell, to indicate that the label has been tampered or altered.

Response to Arguments

9. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 9, 2005

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER